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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/028,581	12/20/2001	Joseph M. Fontana	2356P	3274

7590 04/09/2003

SAWYER LAW GROUP LLP  
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EXAMINER

ELISCA, PIERRE E

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 04/09/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
10/028,581

Applicant(s)  
Joseph M. Fontana et al.

Examiner  
Pierre E. Elisca

Art Unit  
3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE THREE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 12/20/2001
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-39 is/are rejected.
- 7) ☒ Claim(s) 4, 5, 18, 19, 23, 27, 28 is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other:

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**Examiner Pierre Eddy Elisca**

**United States Department of Commerce**

**Patent and Trademark Office**

**Washington, D.C. 20231**

### **DETAILED ACTION**

1. This Office action is in response to Application No. 10/028,581, filed on 12/20/2001.
2. Claims 1-39 are presented for examination.

#### ***Claim Rejections - 35 USC § 102 (b)***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 (b) that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-3, 6-17, 20-22, 24-26 and 29-39 are rejected under 35 U.S.C. 102 (b) as being anticipated by Chou et al. (U.S. Pat. No. 5,222,133).

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As per claims 1, 3, 6-17, 20-24, 26, and 29-39 Chou discloses a method of protecting computer software from unauthorized users, comprising:

encrypting the software to be protected using an encryption key, creating encrypted software (see., abstract, specifically wherein it is stated that an algorithm for processing a plurality of keys including the first key in software, col 2, lines 31-54);

authorizing use of the software on the computer system by generating the encryption key within the security device using information supplied from the software (see., abstract, col 1, lines 26-53, specifically wherein it is stated that a first key (or encryption key) is stored in the program and a second key (or encryption key), physically separate from the program, is supplied to the customer with each program sold in a hardware based register. The first and second keys are compared to see if they bear a predetermined relationship to each other, in which case the program is authorized ); and sending the encryption key from the security device to the computer system for decryption of the software (see., abstract, specifically wherein it is stated that the first and second keys in the algorithm for deriving a control key, please note that the control key is for decrypting the software, and also col 1, lines 7-25).

As per claims 2, and 25 Chou discloses the claimed method of using at least first and second pieces of information to generate an encryption key (see., abstract, please note that first and second pieces of information is readable as first and second keys);

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associating the first piece of information (or first key) with the encrypted software (see., abstract, specifically wherein it is stated that an algorithm for processing a plurality of keys including the first key in software, col 2, lines 31-54); and

storing the second piece of information (or second key) in the security device (see., abstract, specifically wherein it is stated that a second key (or second piece of information), external to the software, to be protected which bears a relationship to the first key, col 2, lines 31-54).

#### **CLAIM OBJECTION**

5. Claims 4, 5, 18, 19, 23, 27, and 28 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### ***Conclusion***

6. Any inquiry concerning this communication from the examiner should be directed to Pierre Eddy Elisca at (703) 305-3987. The examiner can normally be reached on Tuesday to Friday from 6:30AM. to 5:00PM.

If any attempt to reach the examiner by telephone is unsuccessful, the examiner's supervisor, James Trammell can be reached on (703) 305-9768.

**Any response to this action should be mailed to:**

Commissioner of patents and Trademarks

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Washington, D.C. 20231

The Official Fax Number For TC-3600 is:

**(703) 305-7687**

  
Pierre Eddy Elisca

Patent Examiner

**March 31, 2003**